REMARKS

Claims 57 & 58 have been added. The claims now present in this application are claims 37-49 and 55-58.

Applicant elects the species of claim 58. The claims readable on this specie are claims 37, 38, 42, 43, 44, 45, 46, 47, 49 and 55-58. Claims 39-41 and 48 are withdrawn from further consideration under Rule 1.142 (b). These claims are being retained of record pending the filing of the divisional applications directed thereto.

It is submitted that all the claims should be examined together in one application. The basis for this restriction requirement is that the compounds of formula 1 "do not possess single structure element that is shared by all the alternatives which is inventive". While all the common formula 1 embrace a common structural feature ending in benzodiazepine. While the common structural feature of formula 1 is not a patentability over the prior art this is not a requirement for unity of invention under the PCT or a restriction requirement under US Patent Law . All of the compounds of formula 1 not only contain a benzodiazepine ring as a common structural feature, they are also inhibitors of cyclic nuclelotide phosphodiesterase. Either one of these properties is sufficient to establish the propriety of their being claimed under the PCT or under US Patent Law, or in a single clone. Nothing in the rules of the US Patent and Trademark or of the PCT require that the common feature possessed by all the compounds covered by a claim be invented. Nothing the outstanding Office Action cites any rules or law where this is a criteria for establishing a division requirement. Therefore this grounds provides no basis for making a restriction requirement. All that is necessary to avoid a restriction requirement is that there be presented a properly allowable claim generically

covering all of the individual species. This the case with claim 56 which covers all of the claims dependent thereon.

That an application contains a claim which covers two or more possibly divisible inventive species does not make a requirement for restriction or election proper when there is present a properly allowable linking claim generically covering, via a Markush Group, these individual species. These linking claims make these species inseparable from each other especially when they are embraced within a Markush Group. It is this linking claim which links these invention, otherwise divisible. This is in accord with Art. (3)4 III and Rule 13.1 of the Patent Cooperation Treaty, as well as U.S. Patent Law. None of these require that the common feature which inks all of the species be inventive.

Under the rules of the Patent Cooperation Treaty and the U.S. Patent Laws, when an allowable linking claim is present in an application, there is unity of invention. In this case, under the Patent Cooperation Treaty and the MPEP, no division requirement is proper. Under Rule 13.4 of the PCT Regulations, unity of invention also applies to dependent claims

> "claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

As seen from Rule 13.4, the provision of linking claims which cover all compounds, satisfies the requirement of unity of invention. By such claims, a plurality of separate inventions covered under the Markush group are linked as to form a single, general inventive concept which is present in an allowable generic claim. It can be seen that all of these claims include a common structure whose separate inventions are

designated through members of a Markush group. In addition, all of the compounds included within the generic claim 56 are defined by a common structure, as well as a common property and activity, i.e., they are active as inhibitors of cyclic nucleotide phosphordiesterase, therefore, the generic linking claims satisfy Annex B, part 1(f) of PCT Rule 13.2. There is no rejection against these linking claims.

Also, please note MPEP §809.03 which requires that:

"Examiners should use Form Paragraph 8.12 to make restrictions involving linking claims."

> "Claim [1] link(s) inventions [2] and [3]. The restriction requirement [4] the linked inventions is **subject to** the nonallowance of linking claim(s), claim [5]. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application."

Please note that, under MPEP 809.04, like the PCT, once the linking claim is allowed, the restriction requirement should be canceled. Therefore, Applicant is allowed to present linking claims in conjunction with claims directed to these species.

With respect to all members of a Markush Group, all that the PCT Rules require is that all the species embraced within a single allowable generic claim have a common structural feature or activity in order to provide proper unity of invention. These rules governing unity of invention are not concerned with whether the species within the generic Markush Group may be classified in various groups within the U.S. classification system or that they require separate searches of the chemical literature. This is not a requirement of the unity of invention under the PCT Treaty or Rules since the various

separate inventive species of this application are members of a generic Markush Group where these species have a common structural feature and activity, .

It is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber,* 198 U.S.P.Q. 328 (CCPA 1978) at pages 331-332,

> "§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text).

The instant Office Action makes the exact type of restriction expressly forbidden by the CCPA in *In re Weber* (such restriction is tantamount to a rejection). There is no basis under 35 U.S.C. §121 for the Patent Office to make an intraclaim restriction requirement of claim 1 and the subsequent generic claims encompassing the species of claim 137.

Nothing in 35 U.S.C. §121 gives the legal authority to create a "generic concept" and require applicants to amend a particular claim so as to only claim the subject matter limited to embrace the "generic concept." Applicants have the right under U.S. patent law to claim their invention using the limitations that they regard as essential to delineate the invention, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331.

When a new "generic concept" is created numerous issues arise as to who is the inventor of the "generic concept" and whether the specification provide the requisite written description required by 35 U.S.C. §112, first paragraph, of the "generic concept"? Although every species contained within the "generic concept" would be enabled by the specification, the new "generic concept" *per se* could lack a written description required by 35 U.S.C. §112, first paragraph, in the specification as filed. This is the exact situation envisioned in *In re Weber* which states on page 331:

> If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the sub-genera would be defined by the examiner, rather than the applicant, it is not inconceivable that a number of the fragments would not be described by the specification.

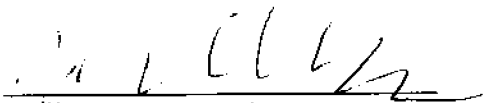
Based upon the foregoing, it is submitted that the Restriction Requirement be withdrawn unless there is a rejection of the linking claims. Therefore, all claims should be examined on their merits.

Correspondence and Fees

Please charge the Petition for One Month Extension of Time fee of $120.00 to Deposit Account No. 03-3839. Authorization is hereby given to charge Deposit Account No. 03-3839 for any underpayment, or to credit any overpayments.

Please address all correspondence to Intellectual Property Docket Administrator, Gibbons, P.C., One Gateway Center, Newark, New Jersey 07102-5310. Telephone calls should be made to William H. Epstein at (973) 596-4607 and fax communications should be send directly to him at (973) 639-6397.

Respectfully submitted,



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